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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,103	01/20/2004	Sylvie Gauthier	6674-0037-1	4659

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,103

Applicant(s)

GAUTHIER ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Reply*

1. This is in response to the Reply filed on 7/21/2005.
2. Upon further consideration, the finality of the previous Office action is hereby withdrawn.
3. Claims 1-21 are currently pending in this application. Claims 8-21 have been withdrawn as directed to non-elected inventions as indicated in Office action of 11/04/2004.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, and 9 of Copending Application, Serial No. 10/762,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other.

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Claims 1-2, 4-7, and 9 of the copending application recite all of the limitations in instant claims 1 and 3-6. Moreover, claims 1 and 6 of the copending application disclose an underlayer and a backer in addition to the core layer and the first decorative layer. Thus, the scope of claims 1 and 6 of the copending application is narrower in scope than that in the instant claims, rendering them obvious over each other.

***Claim Rejections - 35 USC § 102***

6. In view of the prior Office action of 4/19/2005, the rejection of claims 1 and 4-6, under 35 U.S.C. 102(b) as being anticipated by Sturm (US Pat. 2,622,991), has been withdrawn due to further consideration.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturm as applied to claim 1 above, and further in view of Scher et al. (US Pat. 4,25,480).

Sturm teaches a laminate, comprising one or more layers of a thermoplastic material with superposed or interposed layers of a non-thermoplastic material, such as leather, to be printed, colored, or coated (decorative) (see col. 1, ln. 1-12), wherein the thermoplastic material layer is made of paper or wood impregnated with acrylic solution (see paragraph bridging col. 1-2).

Sturm differs from the presently claimed invention in that the reference teaches the paper sheet impregnated with an acrylic solution, instead of phenol-formaldehyde.

Scher teaches a laminate comprising a core layer being a paper sheet impregnated with phenol-formaldehyde, the laminate being about 50 mils (or 1.27 mm), and the laminate coated with a release sheet (see col. 1, ln. 14-65).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the core layer and the release sheet, as taught by Scher in the laminate of Sturm. This is because Scher teaches that the paper sheet impregnated with phenol formaldehyde would have made the laminate cured better under heat and pressure, and the use of a release sheet would have made the laminate easier to handle (see col. 1, ln. 14-16, 62-65).

With respect to the leather thickness and the amount of the resin, Scher teaches the laminate being about 50 mils, which appears to read on the instantly claimed range. Although the Sturm combination does not specifically teach the amount of the resin in the core layer, Scher does teach the amount of the melamine formaldehyde resin in the print sheet to be 35-40% (see col. 2, ln. 57-58). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the amount of the resin in the core layer would have been about 35-40% in the print layer to be effective.

***Response to Arguments***

9. Applicant's arguments filed 7/21/2005 have been fully considered but they are not persuasive.

With respect to the ODP rejection over co-pending application, 10/762, 104, the examiner would like to reiterate that a terminal disclaimer will be addressed when the claims are allowed. However, as it stands now, since the instant claims read over the claims in the copending application, the ODP rejection over the copending application still stands.

With respect to the arguments over the reference of Sturm, Applicants contend that Sturm does not teach a core layer. However, as pointed out in paragraph 6 above and in the prior Office action, Sturm does teach one or more thermoplastic layers with superposed or interposed layers of a non-thermoplastic material. The thermoplastic material layer is made of paper or wood impregnated with acrylic solution, thus the thermoplastic material layer is also a cellulosic layer (paper or wood) and since the layer is interposed with non-thermoplastic layers, the thermoplastic layer is considered as a core layer, as shown in the instant specification and Figures.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Scher teaches a laminate comprising a core layer of paper sheet impregnated with

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phenol-formaldehyde. Thus, Scher is used to illustrate that paper sheet impregnated with phenol-formaldehyde has been taught in the prior art. Hence, Scher is used to remedy Sturm.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

#### ***Contact Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 3, 2005



**THAO T. TRAN**  
**PATENT EXAMINER**